

REMARKS

Claims 1-8, 12, 13, 17, 19-26, 30, 31, 35-42, 46 and 47 are pending in the present application. Claims 1, 17, 19, and 35 were amended. The specification provides support for the amendments from page 9, line 6, to page 11, line 7, which describes Figures 3A-3C. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. §102(b), Alleged Anticipation, Claims 1-3, 6-8, 12, 13, 17, 19-21, 24-26, 30, 31, 35-37, 40-42, 46, and 47

The Office Action rejects claims 1-3, 6-8, 12-13, 17, 19-21, 24-26, 30, 31, 35-37, 40-42, 46, and 47 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent Application No. 2002/0135621 to Anguilo et al. (hereinafter *Anguilo*). This rejection is respectfully traversed.

Regarding independent claim 1, 17, 19, and 35, the Office Action states:

As per claims 1, 17, 19 and 35 Anguilo teaches a computer implemented method and corresponding system for ordering elements included within a list comprising the steps/means:

presenting the set of elements in a list format in a first order in a graphical user (set of elements list box 120 of FIGURE 3); receiving a first user input selecting a set of the element from the list (page 6, paragraph 47);

responsive to detecting the first user input, monitoring for a second user input, indicating a movement of the set of elements within the list; and responsive to detecting the second user input (page 6, paragraphs 46 and 47; selecting MOVE UP 122 or MOVE DOWN 124), automatically reordering the elements in the list including:

when the set of elements are contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements together as one unit as if said set were a single list element to create a modified list of elements in a second order, said set of elements appearing to a user as having been moved simultaneously (page 6, paragraphs 46 and 47); and

when the set of elements are non-contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements as one unit, said set of elements appearing to a user as having been moved simultaneously, wherein each element in the set of elements has a relative order to another

element in the set of elements, and wherein the relative order is preserved (page 6, paragraphs 46 and 47).

Office Action dated July 25, 2005, pages 2-3.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicant respectfully submits that *Anguilo* does not teach every element of the claimed invention arranged as they are in claims 1, 17, 19, and 35 of the present invention.

Amended independent claim 1, which is representative of independent claims 17, 19 and 35 with regard to similarly recited subject matter, recites:

1. A method in a data processing system for ordering elements included within a list, the method comprising:
 - presenting the elements in a list format in a first order in a graphical user interface;
 - receiving a first user input selecting a set of the elements from the list;
 - responsive to detecting the first user input, monitoring for a second user input, indicating a movement of the set of elements within the list; and
 - responsive to detecting the second user input, automatically reordering the elements in the list including:
 - when the set of elements comprises a plurality of contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements together as one unit as if said set were a single list element to create a modified list of elements in a second order, said set of elements appearing to a user as having been moved simultaneously; and
 - when the set of elements comprises a plurality of non-contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements as one unit, said set of elements appearing to a user as having been moved simultaneously, wherein each element in the set of elements has a relative order and spacing are to

another element in the set of elements, and wherein the relative order and spacing are preserved. (Emphasis added).

Anguilo does not teach the features emphasized above. The Office Action alleges that *Anguilo* teaches when the set of elements comprises a plurality of non-contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements as one unit, said set of elements appearing to a user as having been moved simultaneously, wherein each element in the set of elements has a relative order to another element in the set of elements, and wherein the relative order is preserved in the following passage:

[0046] An Up control 122 and a Down control 124 will move a selected image up or down in the list order. Note that the order of the images in list area 120 determines the relative placement (for example, top to bottom in a vertical array) of thumbnail images in a resulting photo gallery. An image at the top of the list in list area 120 will be the first thumbnail image in a photo gallery, while an image at the bottom of the list in list area 120 will be the last thumbnail image in a photo gallery (assuming that the first and last images in the list have been selected to be included in a photo gallery).

[0047] Single or multiple images that appear in sequence can be selected and reorganized. For example, the user may select three adjacent images that currently appear in the middle of the list, which will appear as thumbnail images in a middle section of the resulting photo gallery. After selecting those three images, a user can actuate Down control 124 repeatedly, to move those three images to the end of the list. If no other changes are made, those images will be the last three images in the resulting photo gallery. As noted above, if Dialog box 110 is accessed once a photo gallery has already been generated, the image list displayed in list area 120 will be the contents of the photo gallery. In that case, the up and down controls can be employed to change the order of thumbnail images in the existing photo gallery, by changing the order of the images in the list displayed in list area 120.

Anguilo, page 6, paragraphs 46-47.

In the sections cited above, *Anguilo* teaches moving a selected image up or down in the list order and moving adjacent images to the end of the list. Contrary to the Examiner's allegations, these sections of *Anguilo* do not teach when the set of elements comprises a plurality of non-contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements as one unit, said set of elements appearing to a user as having been moved simultaneously, wherein each element in the

set of elements has a relative order to another element in the set of elements, and wherein the relative order is preserved. *Anguilo* is explicit in teaching the moving of a single element: "move a selected image up or down in the list order." The teachings of *Anguilo* are limited to the moving of a single element or adjacent elements: "the user may select three adjacent images that currently appear in the middle of the list . . . After selecting those three images, a user can actuate Down control 124 repeatedly, to move those three images to the end of the list." There are no provisions in *Anguilo* for automatically reordering the elements in the list when the set of elements are non-contiguous elements. Therefore, *Anguilo*'s teachings are limited to automatically reordering the elements in the list when elements in the set are contiguous elements, but not when the elements in the set are non-contiguous elements.

In contrast to the *Anguilo* disclosure, the present invention, as recited in independent claims 1, 17, 19, and 35, sets forth the features of when the set of elements comprises a plurality of non-contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements as one unit, said set of elements appearing to a user as having been moved simultaneously, wherein each element in the set of elements has a relative order and spacing to another element in the set of elements, and wherein the relative order and spacing are preserved. In contrast to the present invention, in *Anguilo* the possibility of selecting non-contiguous elements is never even mentioned, much less any provision offered for automatically reordering non-contiguous elements. *Anguilo* teaches reordering a set of elements as a contiguous set, explicitly limiting the selection and movement to "adjacent images." How any elements located between selected non-contiguous elements should be handled is not a topic taught or suggested in *Anguilo*. As a result, *Anguilo* does not teach when the set of elements comprises a plurality of non-contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements as one unit, said set of elements appearing to a user as having been moved simultaneously, wherein each element in the set of elements has a relative order and spacing to another element in the set of elements, and wherein the relative order and spacing are preserved.

Therefore, *Anguilo* fails to teach all elements of the claimed invention, and thus fails to anticipate the invention as recited in independent claims 1, 17, 19, and 35.

Furthermore, *Anguilo* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement *Anguilo* when the set of elements comprises a plurality of non-contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements as one unit, said set of elements appearing to a user as having been moved simultaneously, wherein each element in the set of elements has a relative order and spacing to another element in the set of elements, and wherein the relative order and spacing are preserved, one of ordinary skill in the art would not be led to modify *Anguilo* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Anguilo* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicant's disclosure as a template to make the necessary changes to reach the invention.

Therefore, Applicant respectfully requests that the rejection of independent claim 1 under 35 U.S.C. §102 be withdrawn.

Independent claims 17, 19, and 35 recite similar features as claim 1. Therefore, the same distinctions between *Anguilo* and the claimed invention in claim 1 apply for these claims. For the reasons described above, *Anguilo* does not contain all elements of independent claims 1, 17, 19, and 35. Hence, *Anguilo* fails to anticipate the present invention as recited in claims 1, 17, 19, and 35. Since claims 2-3, 6-8, and 12-13 depend from claim 1, claims 20-21, 24-26, and 30-31 depend from claim 19, and claims 36-37, 40-42, and 46-47 depend from claim 35, the same distinctions between *Anguilo* and the claimed invention in independent claims 1, 17, 19, and 35 apply for these claims. Consequently, it is respectfully urged that the rejection of claims 1-3, 6-8, 12-13, 17, 19-21, 24-26, 30-31, 35-37, 40-42, and 46-47 have been overcome, and such a notice is respectfully requested.

II. 35 U.S.C. § 103, Alleged Obviousness, claims 4, 5, 22, 23, 38, and 39

The Office Action has rejected claims 4, 5, 22, 23, 38, and 39 under 35 U.S.C. § 103(a) as being unpatentable over *Anguilo* in view of Examiner Automated Search Tool (hereinafter *EAST*). This rejection is respectfully traversed.

As shown in Figure 3, two non-contiguous elements are selected: first element with a document ID US20020194196 and a second element with document ID US20020184610. Figure 4 shows that after reordering, the two elements are moved simultaneously to the bottom of the list. Figure 5 shows that after reordering, the two elements are moved simultaneously to the top of the list. Thus, in Figures 3-5, *EAST* merely teaches selecting non-contiguous elements and reordering the elements by moving the elements simultaneously either to the bottom or to the top of the list. However, *EAST* does not teach that one element has a relative order and spacing to another element and that the relative order and spacing are preserved. To the contrary, *EAST* does not preserve the spacing between the two elements. As shown in Figures 4 and 5, the two elements become contiguous elements after reordering. Thus, the spacing between the two elements is changed from having a spacing of two elements to having a spacing of zero elements. In addition, *EAST*'s reordering is different from the automatic reordering of the present invention in that the elements in *EAST* do not maintain a relative order and spacing to another element in the list and *EAST* does not preserve the relative order and spacing.

Even if *Anguilo* were combinable with *EAST*, the result of such a combination would not be the invention as recited in independent claims 1, 17, 19, and 35. Rather, such an alleged combination would, at best, result in a tool to create a photo gallery of thumbnail images on a Web page, substantially as taught in *Anguilo*, with a user interface that Patent Examiners use to automatically search patents and publications, in the manner described in *EAST*. The inventions in *Anguilo* and *EAST* are from completely unrelated fields. Even with the alleged additions of *Anguilo* and *EAST*, there would be no ability for when the set of elements comprises a plurality of non-contiguous elements, automatically reordering the elements in the list by moving, within the list, the set of elements as one unit, said set of elements appearing to a user as having been moved simultaneously, wherein each element in the set of elements has a relative order and spacing to another element in the set of elements, and wherein the relative order and spacing are preserved, as recited in claim 1 of the present invention from which claims 2-8 and 12-13 depend.

Furthermore, there is no teaching or suggestion in the references as to the desirability of including the features from other references. The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The Examiner may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification. The only motivation to even attempt to combine *Anguilo* and *EAST* is to try to arrive at Applicant's claimed invention and thus, the alleged combination is a result of impermissible hindsight reconstruction using Applicant's own disclosure as a guide. While Applicant understands that all examination entails some measure of hindsight, when the rejection is based completely on hindsight, as in the present case, rather than only what is gleaned from the references, then the rejection is improper and should be withdrawn.

Therefore, the combination of *Anguilo* and *EAST* does not contain all elements of claims 4, 5, 22, 23, 38, and 39. Additionally, claims 4, 5, 22, 23, 38, and 39 are respectively dependent from claims 1, 19 and 35 that Applicant has already demonstrated to be in condition for allowance. Consequently, it is respectfully urged that the rejection of claims 4, 5, 22, 23, 38, and 39 have been overcome, and such a notice is respectfully requested.

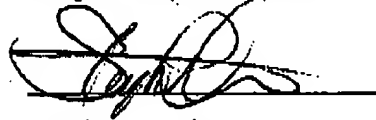
III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: October 20, 2005

Respectfully submitted,



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